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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,856	10/24/2003	Thomas J. Perkowski	100-061USA000	8135
<div>7590 10/05/2007 Thomas J. Perkowski, Esq. Thomas J. Perkowski, Esq., P.C. Soundview Plaza 1266 East Main Street Stamford, CT, 06902</div>			<div>EXAMINER CARLSON, JEFFREY D</div>	
			<div>ART UNIT 3622</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 10/05/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/693,856	PERKOWSKI ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/4/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-30 of copending Application No. 10/602,990. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-30 of this application conflict with claims 1-30 of Application No. 10/602,990. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-30 are system (apparatus) claims, yet they include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act.
 - For example, the language such as kiosk is launched (claim 1), advertising spot is displayed, links are displayed (claim 2), document is served (claim 9), database server serves (claim 10), tag is automatically executed, request...is automatically carried out, GUI displays (claim 11), etc. should be corrected to state that an element of the system "is programmed to <perform the act>".
 - Applicant should review all claims for similar compliance.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern (US6591247) in view of Durst, Jr. et al (US6542933).**

Stern teaches systems and methods for providing networked, in-store kiosks that can be used to deliver product information and advertisements. A centralized server (NMC/NOC 12/20) receives various types of content (ads, information, audio, video, etc) and makes the content available to various stores [fig 1]. Each store has plural kiosk sites 30 including a video screen, keyboard and light pen. The kiosks and servers are connected by way of IP protocol and/or the Internet [4:46-68]. A consumer can scan the UPC barcode of a product at the kiosk and receive advertising and information about the product [6:46-50, 7:14-17, 27-32, 48-50] which provides a positive brand experience. Stern teaches that the central database provides a UPC-indexed database of products that stores the relationship (via the tblUPCmaster table) between the UPC codes and the associated content (ads, information, audio, etc) associated with that product [8:10-25]. Stern teaches that the database provide information and advertising regarding available products, not services. However, Official Notice is taken that Information and Marketing Systems typically deal with products and/or services and it would have been obvious to one of ordinary skill at the time of the invention to have

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provided the features of Stern with any items for sale, including services. The UPC codes of Stern are taken to be equivalent to applicant's USN in that they both provide an item identifier to be used for database lookups to retrieve and deliver advertising and item information. Regarding the first subsystem, Stern teaches that functionality is provided to input ads/information into the system [6:1-34]. The display of ads and information to the requesting user about the requested item is taken to provide a virtual kiosk that displays advertisements and information which are taken to promote the item. Stern does not teach a servlet and triggering HTML tag. Durst, Jr. et al also teaches a means for a consumer to scan a barcode (at a kiosk [8:1-3]) in order send a request to a centralized server for more information about the item scanned. Durst, Jr. et al teaches that the item identification/barcode is scanned into the a web browser and sent to the server. The server determines where the information file(s) are stored and either redirects/links the user to the URL of such information, or the server retrieves the information and delivers it to the requesting user's web browser [3:15-30, 66-67]. Durst, Jr. et al also teaches that because the barcode or other entered identifier does not include the URL of the content, that the server may provide the mapping between the UPC/USN/item identifier and the location of the content by way of a JAVA servlet [6:37-60]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a web-based item request and server delivery mechanism for providing advertising and information about the requested products. Any object in the submission web page (i.e. the well known submit button on a form such as in Durst, Jr. et al FIG 14) is taken to be an HTML tag which triggers the request for ads/information.

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Any web page displaying any content about the requested item is taken to be a “virtual kiosk.” Although any advertisement content is taken to promote the item advertised, therefore providing a promotion, Durst, Jr. et al teaches promotions explicitly which would have been obvious to have included with that of Stern to provide more positive branding. Stern teaches providing ads, audio, video and information about the item. Durst, Jr. et al teaches providing product and other types of information about products. It would have been obvious to one of ordinary skill at the time of the invention to have returned a list of URL links to the user when the product requested is associated with plural content files (ads, promotions, information, warranty, etc), so that the user may choose which content to review. The systems of Stern and Durst, Jr. et al are taken to at least represent online item catalogs. Durst, Jr. et al teaches that plural servers may be provided to carry out the invention. The tags and servlet are automatically created in the proposed system of Stern/Durst, Jr. et al. The HTML documents (web pages) are taken to at least represent service-related documents.

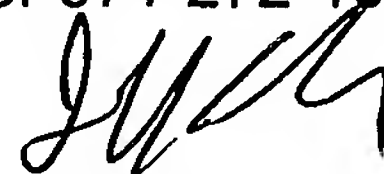
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc